

REMARKS

The Applicants would like to thank the Examiner for the quick and courteous non-final Office Action. The Applicants are again very grateful to the Examiner for allowing claims 40-42.

The claims remaining in the application are 20-29, 31-38 and 40-42. Claims 20-29 and 31-38 are rejected. Independent claims 20, 24, 27, and 38 are amended herein. Claims 1-19, 30, 39 and 43 are cancelled. No new matter has been added.

Priority

The Examiner notes that the application appears to claim subject matter disclosed in prior *provisional* Application No. 60/211162, filed 6/13/2000. The Examiner asserts that a reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is

considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17 (t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP §201.11.

Rejection under 35 U.S.C. §102(e) over Stowe, et al.

The Examiner rejected claims 20-29 and 31-38 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Pat. No. 6,703,351 to Stowe, et al.

The Examiner finds that the applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, the Examiner contends that it constitutes prior art under 35 U.S.C. §102(e). The Examiner notes that this rejection under 35 U.S.C. §102(e) might be overcome either by a showing under 37 CFR §1.132 that any invention dis-

closed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another”, or by an appropriate showing under 37 CFR §1.131.

The Examiner contends that Stowe, et al. teaches the same method of the present invention utilizing the same latex containing fluid, and that the filing date of Stowe, et al. is prior to the claimed filing date of the present application, since it claims priority back to provisional application 60/211,162, while the present application does not, and it thus constitutes prior art.

The Applicants appreciate the Examiner’s helpful suggestions, and respectfully direct the Examiner’s attention to the copy of the Petition filed of even date herewith. In both this Petition and the instant Amendment, (1) the reference required by 35 U.S.C. §120 or §119(e) and 37 CFR §1.78(a)(2) or (a)(5) to the prior provisional application has now been made. (2) The surcharge under 37 CFR 1.17 (t) has been paid in the Petition. Further, (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional has been made in the Petition. The Applicants thus respectfully submit that upon the grant of the Petition, the rejection of claims 20-29, 31-38 and 43 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Pat. No. 6,703,351 to Stowe, et al. should be withdrawn and/or rendered moot. Reconsideration is respectfully requested.

Rejection under 35 U.S.C. §103(a) over GB 2131067

The Examiner rejected claims 20-24, 26-29, 31, 33, 36, and 37 under 35 U.S.C. §103(a) as allegedly unpatentable over GB 2131067 for reasons of obviousness.

The Examiner finds that GB ‘067 teaches a method of drilling using a drilling fluid comprising a latex, water, surfactant, and bentonite which is an aluminosilicate, allegedly the same as the precipitating agent of the present invention. The Examiner asserts that the latexes would have particle sizes within the scope of claim 37. The Examiner admits that GB ‘067 differs from the present invention

in not specifically exemplifying the use of a polyethylene latex. However, the Examiner contends that GB '067 teaches that hydrocarbon homopolymers or copolymers are preferred for use as the latex polymer and specifically teaches ethylene/propylene copolymer. The Examiner alleges that it would be obvious to one of ordinary skill in the art to utilize polyethylene as the polymer of the latex of GB '067, given the teaching that hydrocarbon homopolymers or copolymers are preferred for use as the latex polymer, and the specific teaching of ethylene/propylene copolymer. The Examiner contends that this teaching would lead one having ordinary skill in the art to utilize ethylene homopolymer in the latex of GB '067. Such would obviously inhibit borehole wall invasion as in the present invention the Examiner alleges.

In response to the Amendment filed January 17, 2007, the Examiner finds that the Applicants have argued that it is the examiners burden to establish a prima facie case. The examiner contends that he has clearly met this burden. The burden clearly shifts to the applicant to provide evidence that such prima facie case is incorrect (citing *In re Biasecki* and *In re Thorpe*). With respect to the use of polyethylene in the invention of GB '067, the Examiner alleges that there is a clear preferential suggestion of the reference to use hydrocarbon polymers which can be homopolymers or copolymers (see last two lines of page 1). Thus the Examiner asserts that the teaching of the use of an ethylene/propylene copolymer would be extremely clear motivation to use either of an ethylene or propylene homopolymer, in view of such teaching on the last two lines of page 1 of GB '067. The Examiner contends that one of ordinary skill in the art having such teaching before them would almost instantly envisage the use of a homopolymer of ethylene or propylene, since such is obviousness bordering on anticipation. Furthermore, the homologues of ethylene/propylene copolymer with such similar structures would be expected to have similar utility, the Examiner asserts (citing *Ex parte Faque*). Applicants argue that if polyethylene was intended to be cited, then such would be cited by the applicant. It is clear from the statement of "Examples of suitable homopolymers", that such would clearly not be meant to be an exhaustive list, but only a list of a few of the possibilities which would be

encompassed. The Examiner contends that one of ordinary skill in the art would thus have a great expectation of success in the use of polyethylene in the latex of GB '067. The Examiner asserts that Applicants have not provided any evidence that all of the cited latexes would be unsuitable for the present invention, or some other evidence to distinguish over the prior art of GB '067.

Although the Applicants respectfully disagree with the Examiner's position for the reasons established in the Amendments previously submitted, the Applicants would respectfully direct the Examiner's attention to the amendments to independent claims 20, 24, 27, and 38 herein where the term "polyethylene" has been deleted from each. Applicants thus respectfully submit that the 35 U.S.C. §103 rejection has thus been overcome and the application may progress to allowance. Reconsideration and allowance of the claims are respectfully requested.

Double Patenting Rejection over Application No. 11/437351

The Examiner has provisionally rejected claim 20 is on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-7 of copending Application No. 11/437351. Although the Examiner admits that the conflicting claims are not identical, the Examiner alleges that they are not patentably distinct from each other because although a different term is used of a method of inhibiting fluid loss, and a specific drilling step is not disclosed, the claims of 11/437351 would clearly have the property of inhibiting borewall invasion, and the step of drilling would be obvious over the teaching of a drilling fluid. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The Examiner helpfully suggested that a timely filed terminal disclaimer would overcome the subject double patenting rejection. Thus, the Examiner's attention is respectfully directed to the terminal disclaimer enclosed herewith.

The Applicants thus respectfully submit that the subject rejection is overcome.
The Terminal Disclaimer fee is paid upon filing in Private PAIR.

It is respectfully submitted that the arguments, amendments, Petition and Terminal Disclaimer presented above and/or enclosed herewith overcome the rejections and place the claims in condition for allowance. Reconsideration and allowance of the claims are respectfully requested. The Examiner is respectfully reminded of his continuing duty to indicate allowable subject matter. The Examiner is also invited to call the Applicants' attorney at the number below for any reason, especially any reason that may help advance the prosecution.

Respectfully submitted,
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